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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/028,480	12/19/2001	Ranjit N. Notani	020431.1062	2456
53184	7590	07/07/2005	EXAMINER	
i2 TECHNOLOGIES US, INC. ONE i2 PLACE, 11701 LUNA ROAD DALLAS, TX 75234			PALADINI, ALBERT WILLIAM	
			ART UNIT	PAPER NUMBER
			2125	

DATE MAILED: 07/07/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/028,480

Applicant(s)

NOTANI ET AL.

Examiner

Albert W. Paladini

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 19 December 2001.
- 2a) ☐ This action is **FINAL**.      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-38 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-38 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

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## DETAILED ACTION

### *Claim Rejections - 35 USC § 112*

1. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

2. Claims 1-38 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter, which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

There are no written descriptions of embodiments, which describe the systems of claims 1, 37, 38, the method of claim 13 or the software of claim 25. The detailed description consists of a multiplicity of speculative phrases such as "System 10 may include a number of enterprises 12", "only, and not by way of limitation, electronic marketplace 14 may support procurement collaboration between enterprises 12 o a supply chain", "The level of functionality provided by a collaboration service 22 may depend on the degree to which collaboration service 22 understands supply chain semantics. Semantics may include the meaning of instructions and data ( in contrast to the format of such instructions and data and supply chain semantics may include semantics pertaining to an underlying supply chain.", "a collaboration service 22 that understands the necessary supply chain semantics may receive a supply chain message (which may include an RFQ", "a collaboration service 22 that does not understand the necessary supply chain semantics may be unable to determine the meaning of the contents of a supply chain message, or make decisions regarding the handling of the message based on the contents of the message and may, therefore, be limited in its functionality", "System 30 may include a collaboration service designer 32 and a collaboration service generator 34.", collaboration service designer 32 may include JAVA-based or other suitable software executable on a computer system", "Collaboration service designer 32 may expose only certain aspects of a collaboration service 22", "Collaboration service designer may generate an XML ore other suitable file 38 containing information reflection a collaboration service 22 designed by a user". In addition to the lack of a specific embodiment, the specification consists of only speculative possibilities Page 12 states "Although particular meta-model elements are described herein, the present invention contemplates any suitable meta-model elements

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being included within a meta-model." A discussion of enablement is provided in MPEP 2106 V B 2 below, which incorporates the decisions of *In re Scarbrough*, 500 F.2d 560, 565, 182 USPQ 298, 301-02 (CCPA 1974), *In re Gunn*, 537 F.2d 1123, 1127-28, 190 USPQ 402, 405 (CCPA 1976); *In re Brandstadter*, 484 F.2d 1395, 1406-07, 179 USPQ 286, 294 (CCPA 1973); and *In re Ghiron*, 442 F.2d 985, 991, 169 USPQ 723, 727-28 (CCPA 1971).

#### "2106 V B 2. Enabling Disclosure

An applicant's specification must enable a person skilled in the art to make and use the claimed invention without undue experimentation. The fact that experimentation is complex, however, will not make it undue if a person of skill in the art typically engages in

such complex experimentation. For a computer-related invention, the disclosure must enable a skilled artisan to configure the computer to possess the requisite functionality, and, where applicable, interrelate the computer with other elements to yield the claimed invention, without the exercise of undue experimentation. The specification should disclose how to configure a computer to possess the requisite functionality or how to integrate the programmed computer with other elements of the invention, unless a skilled

artisan would know how to do so without such disclosure. See, e.g., *Dossel*, 115 F.3d at 946-47, 42 USPQ2d at 1884-85; *Northern Telecom v. Datapoint Corp.*, 908 F.2d 931, 941-43, 15 USPQ2d 1321, 1328-30 (Fed. Cir.1990) (judgment of invalidity reversed for clear error where expert testimony on both sides showed that a programmer

of reasonable skill could write a satisfactory program with ordinary effort based on the disclosure); *DeGeorge v. Bernier*, 768 F.2d 1318, 1324, 226 USPQ 758, 762-63 (Fed. Cir. 1985) (superseded by statute with respect to issues not relevant here) (invention was adequately disclosed for purposes of enablement even though all of the circuitry of a word processor was not disclosed, since the undisclosed circuitry was deemed inconsequential because it did not pertain to the claimed circuit); *In re Phillips*, 608 F.2d 879, 882-83, 203 USPQ 971, 975 (CCPA 1979) (computerized method of generating printed architectural specifications dependent on use of glossary of predefined

standard phrases and error-checking feature enabled by overall disclosure generally defining errors); *In re Donohue*, 550 F.2d 1269, 1271, 193 USPQ 136, 137 (CCPA 1977) ("Employment of block diagrams and descriptions of their functions is not fatal under 35 U.S.C. 112, first paragraph, providing the represented structure is conventional and can be determined without undue experimentation."); *In re Knowlton*, 481 F.2d 1357, 1366-68, 178 USPQ 486, 493-94 (CCPA 1973) (examiner's contention that a software invention needed a detailed description of all the circuitry in the

complete hardware system reversed).

For many computer-related inventions, it is not unusual for the claimed invention to

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involve more than one field of technology. For such inventions, the disclosure must satisfy

the enablement standard for each aspect of the invention. See *In re Naquin*, 398 F.2d 863, 866, 158 USPQ 317, 319 CCPA 1968) ("When an invention, in its different aspects, involves distinct arts, that specification is adequate which enables the adepts of

each art, those who have the best chance of being enabled, to carry out the aspect proper to their specialty."); *Ex parte Zechnall*, 194 USPQ 461, 461 (Bd. App. 1973) ("appellants' disclosure must be held sufficient if it would enable a person skilled in the electronic computer art, in cooperation with a person skilled in the fuel injection art, to make and use appellants' invention"). As such, the disclosure must teach a person skilled

in each art how to make and use the relevant aspect of the invention without undue experimentation. For example, to enable a claim to a programmed computer that determines and displays the three-dimensional structure of a chemical compound, the disclosure must

- enable a person skilled in the art of molecular modeling to understand and practice the underlying molecular modeling processes; and
- enable a person skilled in the art of computer programming to create a program that directs a computer to create and display the image representing the three-dimensional structure of the compound.

In other words, the disclosure corresponding to each aspect of the invention must be enabling to a person skilled in each respective art.

In many instances, an applicant will describe a programmed computer by outlining the significant elements of the programmed computer using a functional block diagram.

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personnel should review the specification to ensure that along with the functional block diagram the disclosure provides information that adequately describes each "element" in

hardware or hardware and its associated software and how such elements are interrelated. See *In re Scarbrough*, 500 F.2d 560, 565, 182 USPQ 298, 301-02 (CCPA 1974) ("It is not enough that a person skilled in the art, by carrying on investigations along the line indicated in the instant application, and by a great amount of

work eventually might find out how to make and use the instant invention. The statute requires the application itself to inform, not to direct others to find out for themselves (citation omitted)."); *Knowlton*, 481 F.2d at 1367, 178 USPQ at 493 (disclosure must constitute more than a "sketchy explanation of flow diagrams or a bare group of program

listings together with a reference to a proprietary computer on which they might be run").

See also *In re Gunn*, 537 F.2d 1123, 1127-28, 190 USPQ 402, 405 (CCPA 1976); *In re Brandstadter*, 484 F.2d 1395, 1406-07, 179 USPQ 286, 294 (CCPA 1973); and *In re Ghiron*, 442 F.2d 985, 991, 169 USPQ 723, 727-28 (CCPA 1971)."

Appropriate correction and clarification are required.

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter, which the applicant regards as his invention.

4. Claims 1-12 and 25-36 and 38 are rejected under 35 U.S.C. 112, second paragraph, as being incomplete for omitting essential elements and structural cooperative relationships of elements, such omission amounting to a gap between the necessary elements and structural connections. See MPEP § 2172.01.

### **Claim 1**

Although the claim recites "A computer-implemented system, it recites only one operable element, "a collaboration service designer, comprising software operable to". This is followed by a list of desired objectives, which this single element is purported to perform. It is akin to a black box which purports numerous capabilities without the technical support, as in accordance with the court decisions of *In re Scarbrough*, 500 F.2d 560, 565, 182 USPQ 298, 301-02 (CCPA 1974) , *In re Gunn*, 537 F.2d 1123, 1127-28, 190 USPQ 402, 405 (CCPA 1976); *In re Brandstadter*, 484 F.2d 1395, 1406-07, 179 USPQ 286, 294 (CCPA 1973); and *In re Ghiron*, 442 F.2d 985, 991, 169 USPQ 723, 727-28 (CCPA 1971).

### **Claim 25**

The claim recites only one operable element, "software embodied in computer-readable media and when executed operable to". This is followed by a list of desired objectives, which this single element is purported to perform. It is akin to a black box which purports numerous capabilities without the technical support, as in accordance with the court decisions of *In re Scarbrough*, 500 F.2d 560, 565, 182 USPQ 298, 301-02 (CCPA 1974) , *In re Gunn*, 537 F.2d 1123, 1127-28, 190 USPQ 402, 405 (CCPA

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1976); In re Brandstadter, 484 F.2d 1395, 1406-07, 179 USPQ 286, 294 (CCPA 1973); and In re Ghiron, 442 F.2d 985, 991, 169 USPQ 723, 727-28 (CCPA 1971).

### **Claim 38**

Although the claim recites "A computer-implemented system, it recites only one operable element, "a collaboration service designer, comprising software operable to". This is followed by a list of desired objectives, which this single element is purported to perform. It is akin to a black box which purports numerous capabilities without the technical support, as in accordance with the court decisions of In re Scarbrough, 500 F.2d 560, 565, 182 USPQ 298, 301-02 (CCPA 1974) , In re Gunn, 537 F.2d 1123, 1127-28, 190 USPQ 402, 405 (CCPA 1976); In re Brandstadter, 484 F.2d 1395, 1406-07, 179 USPQ 286, 294 (CCPA 1973); and In re Ghiron, 442 F.2d 985, 991, 169 USPQ 723, 727-28 (CCPA 1971).

Appropriate correction and clarification are required.

5. Claim 37 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

### **Claim 37**

Line 4 recites "means for providing a graphical user interface". A graphical user interface" would appear to be some hardware accessible to a user. It is not understood what means would be able to create this hardware. The specification does not provide support for a means for provide this "graphical user interface".

Appropriate correction and clarification is required.

***Claim Rejections - 35 USC § 102***

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

7. Claims 1-38 are rejected under 35 U.S.C. 102(e) as being anticipated by Planalp (6862585).

This rejection is made to the extent that the claims were understood by addressing what appear to be the objectives of the invention.

Planalp discloses a computer-implemented system and method for generating collaboration services. On lines 35-61 in column 7 (depicted in figure 3), Planalp discloses the user interfaces 192 which solicit and receive information regarding user requirements. On lines 11-20 in column 13 (depicted in figure 9), Planalp disclose the flow chart, which takes the user, inputted information, generates a meta-model in blocks 610-630, and generates the supply chain services in block 660.

***Relevant Prior Art***

8. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

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Notani (6442528) discloses a system, which combines HUB user interfaces to obtain data and directions for supply chain enterprises and site planning for the design and deployment of a workflow for enterprise collaboration.

Baseman (6671673) discloses a method to generate a strategic business plan using models which integrate financial management and result in the design of a supply chain and its services.


Clark (6823340) discloses a system and method for collaborative planning where the user, who is a buyer or group of buyers who may access information on a hub. Each individual supply chain automation is specific to a specific user or collaborator, and there is an integrated system for sharing information.

9. Any inquiry concerning this communication or earlier communication from the examiner should be direct to Albert W. Paladini whose telephone number is (571) 272-3748. The examiner can normally be reached from 7:00 to 3:00 PM on Monday, Tuesday, Thursday, and Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mr. Leo P. Picard, can be reached on (571) 272-3749. The official fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0956.

July 5, 2005

  
Albert W. Paladini  
Primary Examiner  
Art Unit 2125